

THIS OPINION IS NOT  
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THE TTAB

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Butler

**Mail date: April 20, 2004**

**Opposition No. 9155195**

**E. & J. Gallo Winery**

**v.**

**Cerveceria Centroamericana  
S.A.**

**Before Bucher, Holtzman, and Rogers, Administrative Trademark  
Judges.**

**By the Board:**

Applicant seeks to register the mark GALLITO for "beer, ale, porter, mineral and carbonated drinking water."<sup>1</sup> As grounds for the opposition, opposer alleges that "gallo" means "rooster" in Italian and Spanish; that "gallito" means "little rooster" in Italian and Spanish; that applicant's mark as used on the identified goods so resembles opposer's previously used and registered GALLO, GALLO-formative and rooster design marks as to be likely to cause confusion, mistake or to deceive; and that applicant's mark will cause dilution of the distinctive quality of opposer's marks, which became well known and famous before applicant began use of its mark.

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<sup>1</sup> Application Serial No. 76380736, filed on March 8, 2002, claiming a bona fide intention to use the mark in commerce.

Opposer pleads the following registered marks: GALLO for "wines";<sup>2</sup> ERNEST & JULIO GALLO for "wines";<sup>3</sup> GALLO and design for "prepared meat products-namely, salame, sausage, mortadella, cured meats; and cheese";<sup>4</sup> GALLO, stylized, for "wines and champagnes";<sup>5</sup> GALLO for "prepared meat products-namely, salame, sausage, mortadella, cured meats; and cheese";<sup>6</sup> GALLO for "corkscrews and place card holders";<sup>7</sup> JULIO R. GALLO in signature stylization for "wines";<sup>8</sup> ERNEST GALLO in signature stylization for "wines";<sup>9</sup> GALLO SONOMA for "wines";<sup>10</sup> GALLO OF SONOMA and

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<sup>2</sup> Registration No. 444756, issued on March 24, 1953, and claiming use anywhere and use in commerce since 1909. Third renewal.

<sup>3</sup> Registration No. 778837, issued on October 20, 1964, and claiming use anywhere and use in commerce since August 4, 1958. First renewal.

<sup>4</sup> Registration No. 887959, issued on March 17, 1970, and claiming use anywhere since November 19, 1962 and use in commerce since July 22, 1968. Second renewal.

<sup>5</sup> Registration No. 891339, issued on May 19, 1970, and claiming use anywhere and use in commerce since 1909. Second renewal.

<sup>6</sup> Registration No. 1319587, issued on February 12, 1985, and claiming use anywhere since November 19, 1962 and use in commerce since July 22, 1968. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

<sup>7</sup> Registration No. 1650478, issued on July 9, 1991 under Section 44(e) of the Trademark Act. Section 8 affidavit accepted; Section 15 affidavit acknowledged; first renewal. The underlying application to this registration was originally filed by, and registered to, a German company, Gallo Designs - Collection Fur Modernes Wohnen GmbH, in multiple classes for many goods. Subsequently, the registration was assigned to opposer (recorded at Reel 0851, Frame 0901), and all goods, but the two items identified, have been cancelled.

<sup>8</sup> Registration No. 1813967, issued on December 28, 1993, claiming use anywhere and use in commerce since August 1972. Section 8 affidavit accepted; Section 15 affidavit acknowledged; first renewal.

<sup>9</sup> Registration No. 1815078, issued on January 4, 1994, claiming use anywhere and use in commerce since August 1972. Section 8 affidavit accepted; Section 15 affidavit acknowledged; first renewal.

<sup>10</sup> Registration No. 1911682, issued on August 15, 1995, claiming use anywhere and use in commerce since June 20, 1994. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

design for "wines";<sup>11</sup> GALLO for "clothing, namely, T-shirts, sweatshirts, shirts and caps";<sup>12</sup> rooster crest design for "wines";<sup>13</sup> and two-roosters design for "wines."<sup>14</sup>

In its answer, filed April 4, 2003, applicant denies the salient allegations of the notice of opposition.<sup>15</sup> Applicant affirmatively asserts that opposer is estopped from alleging that its GALLO marks and applicant's GALLITO marks are similar because opposer previously "represented and admitted" that GALLO is a surname, representing the family name of certain individuals associated with opposer; and that opposer is estopped from claiming exclusive rights to words with meanings equivalent to ROOSTER in connection with food and beverage because numerous third-party uses of ROOSTER and rooster designs exist.<sup>16</sup>

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<sup>11</sup> Registration No. 2231215, issued on March 9, 1999, claiming use anywhere and use in commerce since September 1, 1997. Section 8 and Section 15 affidavits filed.

<sup>12</sup> Registration No. 2320063, issued on February 20, 2000, claiming use anywhere and use in commerce since May 1, 1988.

<sup>13</sup> Registration No. 838504, issued on November 7, 1967, claiming use anywhere and use in commerce since September 13, 1965. First renewal.

<sup>14</sup> Registration No. 2159050, issued on May 19, 1998, claiming use anywhere and use in commerce since July 1, 1993. Section 8 affidavit accepted, Section 15 affidavit acknowledged.

<sup>15</sup> Applicant's requests, in its answer, that paragraph nos. 8-10 of the notice of opposition be stricken as irrelevant are denied. Applicant has not brought a motion to strike making a showing that the allegations set forth are irrelevant to this proceeding.

<sup>16</sup> Although applicant titles these assertions as "affirmative defenses," they are actually, and more appropriately, amplifications of applicant's denial of the salient allegations of the notice of opposition, and explanations as to why applicant believes there can be no likelihood of confusion and dilution. The "estoppel" being alleged by applicant are not true equitable defenses. Applicant's assertion that opposer "represented and admitted" that GALLO is a surname goes to an evidentiary issue: that opposer is estopped from entering evidence that would show the term is other than the surname of opposer's founder and, at least some, of the family associated with opposer's business; and, as such, has a different connotation than

This case now comes up on applicant's fully briefed motion, filed May 30, 2003, for summary judgment dismissing opposer's claims of likelihood of confusion and dilution.<sup>17</sup>

In support of its motion, applicant argues that there are no genuine issues of material fact that the parties' respective marks are so dissimilar in connotation, appearance and pronunciation that, even if the goods were to be considered identical, no likelihood of confusion exists. Applicant contends that opposer is estopped from arguing that its GALLO mark means "rooster" because opposer, "[b]y its Stipulation..." with applicant made during this proceeding, now has stipulated that its GALLO mark is derived from its founder's surname. Applicant further contends that, even if opposers' marks "...were taken to mean or connote ROOSTER, there is no dispute that Applicant's GALLITO mark differs in appearance, sound, connotation, and commercial impression." More particularly, applicant argues that there is no allegation that GALLO is understood by consumers to be in the Spanish or Italian languages; and that GALLITO is only a Spanish term, without a meaning in English. Applicant also argues that numerous other registrations for GALLITO exist and that opposer did not object to Pasatiempos Gallo's registration of GALLITO for

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applicant's "little rooster" mark; and, thus, there can be no likelihood of confusion. Applicant's assertion that opposer cannot claim exclusive rights to words meaning ROOSTER because of numerous third-party uses is merely an argument that opposer's marks are only entitled to a limited scope of protection.

<sup>17</sup> The Board regrets the delay occasioned in considering this motion.

playing cards and board games.<sup>18</sup> While applicant contends that the parties' respective marks are so dissimilar that no likelihood of confusion exists, applicant nonetheless maintains that the parties' respective goods "...are vastly different having different marketing such that no likelihood of confusion could be found."

Applicant's motion is accompanied by 1) the parties' stipulation dated May 28 and 30, 2003 wherein opposer stipulates, in part, that "... GALLO is the surname of the founders of E. & J. Gallo Winery. It is further stipulated that Opposer continues to be owned by the GALLO family."; 2) a copy of an amendment to then pending application Serial No. 73784199, dated November 6, 1989 and made by opposer's predecessor-in-interest, requesting, in part, reconsideration of the refusal to register GALLO on the Principal Register on the ground that the mark is primarily merely a surname, relying on an English dictionary definition that, in English, "Gallo" denotes something related to Gaul and France; 3) two English language dictionary definitions of "Gallo" as indicating Gaul or France or "of Gaul" or "of France"; 4) an English language pronunciation guide showing that "Gallo" in English is pronounced "GA-loh"; 5) a Spanish dictionary pronunciation guide supporting applicant's position that "gallito" is pronounced "gay-yee-to" in Spanish, and that

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<sup>18</sup> Opposer did object to Pasatiempos Gallo's use of GALLO on playing cards and board games. See *E & J Gallo Winery v. Pasatiempos Gallo*, SA., 905 F. Supp. 1403 (E.D. Cal. 1994).

"gallito" means "1. somebody, important person. 2. cock of the walk, boaster, bragger. 3. dart. 4. aggressive or quarrelsome person" in Spanish, and that "gallo" means "1. cock, rooster. 2. dory. 3. aging man, oldtimer. 4. false note...", among other meanings, in Spanish; 6) an online dictionary definition of "gallito" as "to be a tough guy; to act tough"; and 7) five printouts from TARR of registered marks including the term GALLITO with given translations as "little rooster" or "small cock."<sup>19</sup>

As a preliminary matter, opposer contends that applicant brought its summary judgment motion only with respect to opposer's likelihood of confusion claim and does not address opposer's dilution claim. In response to applicant's motion, opposer argues that applicant has not submitted sufficient evidence on which the Board can grant summary judgment on the merits or, even to shift to opposer the burden of proffering evidence sufficient to establish a genuine issue of material fact. Opposer argues that the parties' respective marks are similar in appearance, identical in the first four letters and the last letter; that the marks are similar in sound, there being

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<sup>19</sup> EL GALLITO for "picante sauce and mole paste" (Registration No. 2264003); EL GALLITO BRAND LONG GRAIN RICE" for "long grain milled rice for human consumption" (Registration No. 2542905); GALLITO for "confectionery namely, chocolate, hard and filled candies" (Registration No. 1494424); GALLITO and design for "confectionery namely, chocolate, hard and filled candies" (Registration No. 1489582); EL GALLITO for "playing cards" (Registration No. 1790389); and EL GALLITO for "equipment sold as a unit for playing board games" (Registration No. 1878728).

no correct way to pronounce a trademark, and no way for a consumer to know that one trademark owner may intend its mark to be pronounced a specific way; that the marks are similar in meaning because trademark meaning is based on the term as perceived by the consumer, not as a trademark owner may intend it to be perceived. Opposer argues that applicant's emphasis on the dictionary meaning of the term "gallo" is irrelevant in the context of the GALLO trademark which, according to opposer, is well known to consumers and has been in use for nearly 70 years. Opposer contends that applicant is attempting to apply the patent doctrine of file wrapper estoppel in urging the Board to make a determination that consumers understand the house mark of California's largest winery to mean "France," based on a statement made by opposer's German predecessor-in-interest to one of opposer's registrations (No. 1650478). Opposer argues that any such statements made with respect to trademarks have consistently been held by the courts and the Board as merely evidence to be weighed by the trier of fact. Opposer also argues that the similarity of the marks is not to be determined out of marketplace context and, here, opposer has a well known and famous mark, entitled to the broadest protection; the involved goods are related, travel in the same channels of trade, and often emanate from the same source; and the involved goods are impulse purchases not requiring a great deal of sophistication from the consumer.

Opposer's response is accompanied by the following: 1) a chart outlining opposer's statement of facts and referencing the parties' respective exhibits; 2) the declaration of Gerry Glasgow, opposer's Vice President of Marketing for nearly 20 years, averring, for example, to the types of goods upon which the GALLO mark is used, the meaning of the term as "rooster" in Spanish and Italian and the use of the rooster symbol by opposer, sales volume, promotion expenditures, consumer recognition of GALLO as a California wine, and the relatedness of the parties' involved goods; and 3) the declaration of Paul W. Reidl, Associate General Counsel for opposer in support of accompanying exhibits, including Internet printouts, as follows: printouts from applicant's website indicating that it is a brewery and uses the word GALLO for beer outside of the United States; a copy of the file wrapper for application Serial No. 247408 when applicant filed to register GALLO and design for beer and opposer's GALLO mark was cited against applicant; a copy of a 1982 letter from applicant to opposer suggesting a beer and wine distribution arrangement, in which applicant's President states that the term "gallo" means "rooster" in Spanish; a copy of a letter from opposer's counsel to applicant's counsel, dated May 2, 2003, questioning the propriety of applicant's denials in its answer and questioning the propriety of applicant's first affirmative defense; the May 9, 2003 response thereto of applicant's attorney; the May 16, 2003 response thereto of opposer's counsel;



opposer's July 22, 1946 response to an office action for then pending Serial No. 496376 (now Registration No. 444756) stating that GALLO means "rooster or cock or coq"; and a copy of the file wrapper of applicant's pending application Serial No. 76328179 for the mark ROOSTER for "beer."

In reply, applicant argues that, because the parties' respective marks are dissimilar, applicant's mark is not identical or substantially similar to opposer's mark such that no dilution occurs. Applicant contends that its motion sets out undisputed facts under identified headings, thus, "Opposer incorrectly states Applicant's Summary Judgment Motion lacks a statement of material facts not genuinely in dispute."<sup>20</sup> Applicant again argues that, while opposer objected to Pasatiempos Gallo's use of GALLO for playing cards and board games, it did not object to Pasatiempos Gallo's use and registration of GALLITO for the same goods.<sup>21</sup> Applicant clarifies that its position is "...that a likelihood of confusion cannot be found because the respective marks are dissimilar in

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<sup>20</sup> It is apparent from reading opposer's brief that it is not in agreement with applicant's analysis of what facts are undisputed. Thus, applicant's use of headings to identify what it believes, or would like the Board and opposer to believe, to be undisputed facts, does not mean that opposer must accept those statements as undisputed fact. Opposer indicates that it does not agree that all the facts applicant has identified as "undisputed" are, indeed, "undisputed."

<sup>21</sup> Applicant's persistent reliance on the existence of Pasatiempos Gallo's registrations for GALLITO is puzzling because the existence of said registrations does not preclude opposer's opposition to the registration of applicant's mark. Pasatiempos Gallo's goods, for example, are quite different from opposer's and applicant's goods involved in this opposition.

sight, sound and meaning, even if Opposer could establish at trial that the remaining *Dupont*<sup>22</sup> factors are satisfied in its favor." Applicant argues that opposer is requesting the Board impose a *per se* rule that all food products are deemed related because they may be sold in the same markets. Finally, applicant argues that opposer does not allege what its trademark means to consumers; i.e. whether consumers understand it to be Italian or Spanish or a surname.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56. A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ 1542 (Fed. Cir. 1992).

After carefully reviewing the record, the Board finds that applicant has failed to carry its burden of establishing that no genuine issues of material fact exist. The Board finds that

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<sup>22</sup> *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973).

genuine issues of material fact exist, at a minimum, as to the similarity of the marks, including their appearance, sound, connotations, and commercial impressions. In addition, genuine issues of material fact remain as to the relatedness of the involved goods and their channels of trade. Although applicant's motion is not clear as to whether it was seeking summary judgment on opposer's claim of dilution, to the extent it was, genuine issues of material fact exist as to whether the parties' respective marks are substantially similar, and whether actual dilution and/or a likelihood of dilution exists.

Accordingly, applicant's motion for summary judgment is denied.

Proceedings are resumed. The parties are allowed until **thirty days** from the mailing date of this decision each to respond to the outstanding discovery requests of its adversary.<sup>23</sup> Discovery and trial dates are reset as indicated below:

THE PERIOD FOR DISCOVERY TO CLOSE:	September 15, 2004
30-day testimony period for party in position of plaintiff to close:	December 14, 2004
30-day testimony period for party in position of defendant to close:	February 12, 2005

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<sup>23</sup> In its motion, filed May 30, 2003, to suspend pending disposition of its motion for summary judgment, applicant indicates that the parties have exchanged discovery requests, but agree to stay responses pending disposition of applicant's summary judgment motion. (The motion to suspend indicates that applicant served its requests on April 28, 2003, and opposer served its requests on May 2, 2003.) The parties are advised that the setting of this time to respond to the outstanding discovery requests is not an order compelling discovery but, simply, a scheduling order, intended to facilitate the service of response to the identified, previously served and still pending discovery requests.

15-day rebuttal testimony period  
to close:

March 29, 2005

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Rule 2.125.

Briefs shall be filed in accordance with Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Rule 2.129.

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